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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,624	09/29/2003	Charles Colby	137.04-P-USA	2543

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MICHAEL A. SHIPPEY, PH. D.
4848 LAKEVIEW AVENUE
SUITE B
YORBA LINDA, CA 92886

EXAMINER

LEE, PING

ART UNIT PAPER NUMBER

2644

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,624

Applicant(s)

COLBY, CHARLES

Examiner

Ping Lee

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim 1 recites the limitations "said opposite ends' center" in line 4, "said opposite flat end" in line 14 and "said end" in line 15. There is insufficient antecedent basis for each of these limitations in the claim.

Claim 2 has similar defects as listed for claim 1.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,628,789 in view of Stone (US 2,419,798).

Regarding claim 1, claim 1 of patent '789 specifies each and every limitation of instant application with the exception of a plurality of spring clips extending from the surface of the spindle and acting to secure the spindle to the interior core of the toilet paper. Stone teaches how to securely mounting the toilet paper to the spindle using a plurality of spring clips (16). Thus, it would have been obvious to one of ordinary skill in the art to modify claim 1 of patent '789 by incorporating spring clips as suggested by Stone in order to secure the toilet paper roll to the spindle.

Regarding claim 2, claim 1 of patent '789 specifies each and every limitation of instant application with the exception of a plurality of spring clips extending from the surface of the spindle and acting to secure the spindle to the interior core of the toilet paper. This limitation has been addressed above in view of Stone. Claim 1 of patent '789 also fails to show the spindle inserting into the single clip of a single-clip toilet paper roll holder. It was well known to those in the art that there were various design of spindle and the corresponding toilet paper holder. Claim 1 of patent '789 defines one type, while claim 2 of instant application specifies another well known type. However, the concept of modifying the interior of the spindle to incorporate the recording and playback mechanism and the associated elements could be used for any spindle

holding the toilet paper as long as there is a space available. One skilled in the skill would not have any unexpected result. Thus, it would have been obvious to one of ordinary skill in the art to modify claims of patent '789 in view of Stone by utilizing the teaching of placing the recording and playback mechanism and the associated elements within the spindle for a standard toilet paper holder for another spindle, such as the one for a single-clip toilet paper holder, in order to provide the similar sound effect for different kind of toilet paper holder.


Regarding claims 3 and 5, claim 1 of patent' 789 fails to specify the recording and playback mechanism capable of recording and playback of owner's or operator's voice. Claim 1 of patent '789 specifies an electronic digital recording and playback mechanism. One skilled in the art would have expected that the recording function could be used to record any voice, including the owner's or operator's voice. Once recorded, one skilled in the art would have expected that recorded message could be reproduced using the claimed playback mechanism in patent '789.

Regarding claims 4 and 6, claim 1 of patent' 789 fails to specify the recording and playback mechanism is pre-recorded. Claim 1 of patent '789 specifies an electronic digital recording and playback mechanism. One skilled in the art would have expected that the playback mechanism would be able to reproduce any sound, including noise, recorded during the first use.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ping Lee whose telephone number is 571-272-7522. The examiner can normally be reached on Monday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ping Lee
Primary Examiner
Art Unit 2644

pwl